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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,057	02/05/2001	David Leslie	11-SW-4913	2498

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EXAMINER	
BARTUSKA, FRANCIS JOHN	
ART UNIT	**PAPER NUMBER**
3627	

DATE MAILED: 05/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/777,057	LESLIE ET AL.	
	Examiner	Art Unit	
	F. J. BARTUSKA	3627	MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29 and 32-47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-29,32-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 15-18 and 20-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of Smith et al. Henson discloses a system and method for automatically customizing and specifying a purchase using a computer network-based system including a server coupled to a database 24 and a client system. The system includes a configurator 18, a plurality of interfaces that include drop down menus, see Figs 3A, 3B, 4 and 5, a pricing module 28 and means to submit an order and arrange payment and delivery of the order. Henson does not disclose making a drawing of the selected configuration. Smith et al disclose a graphical user interface for specifying a configuration of a product to be ordered that includes making a drawing of the selected product, see col. 10, lines 36-40. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Smith et al to provide the system of Henson with means to make a drawing of the selected configuration for use in other applications.

Claims 1-10, 14, 19 and 39-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of Chouinard, cited herewith, in further view of Farrell et al. Henson discloses a system and method for automatically customizing and specifying a purchase using a computer network-based system including a server coupled to a database 24 and a client system. The system includes a configurator 18, a plurality of interfaces that include drop down menus, see Figs 3A, 3B, 4 and 5, a pricing module 28 and means to submit an order and arrange payment and delivery of the order. Henson does not disclose making a drawing of the selected configuration and an electrical schematic. Also, Henson does not disclose that the items being purchased are switchgear products. Chouinard discloses in col. 1, lines 41-61 that the drawings and electrical schematics for computer designed projects can be printed on printer 109, see col. 4, lines 13-17. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Chouinard to provide the system of Henson with means to print drawings of the selected configuration and an electrical schematic for use in other applications. Farrell et al disclose a

system for ordering any sort of industrial product over the Internet. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Farrell et al to offer for sale any kind of industrial product, including switchgears, with the system of Henson.

4. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of Chouinard and Farrell et al as applied to claim 1 above. Further, Henson discloses displaying delivery information and customer information in Figs. 7 and 9. Displaying other information of the transaction, such as transaction numbers or methods of confirmation, would involve only an obvious design choice to one of ordinary skill in the art in view of the many sorts of information displayed by Henson. Moreover, merely calling for printing of price quotes would involve only a notorious expedient of the art.

5. Claims 32-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson in view of Farrell et al. The necessary working memory of the online store of Henson is a computer readable medium that receives a record of a customer submitted configuration, matches the customer submitted configuration for a particular

configuration of a system and records the results for purchase by the customer. Henson does not disclose that the items being purchased are switchgear products. Farrell et al disclose a system for ordering any sort of industrial product over the Internet. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Farrell et al to offer for sale any kind of industrial product, including switchgears, with the system of Henson.

Response to Arguments

6. In response to applicant's argument that Henson is not for automatically customizing and specifying a parallel switchgear system, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to

the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

The applicants' remarks that there is no motivation to combine Henson and Farrell et al have been considered but have not been found persuasive because Farrell et al teach ordering any type of industrial product using inter-computer networks such as the Internet. Therefore, in view of this teaching of Farrell et al, an inter-computer network that is for ordering industrial products such as computers can be used to order any industrial product. Hence, the network of Henson can be used to order any industrial product.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of

this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. J. BARTUSKA whose telephone number is 703-308-1111. The examiner can normally be reached on MONDAY-FRIDAY (ALTERNATE FRIDAYS OFF).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ROBERT P. OLSZEWSKI can be reached on 703-308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

fjb

F. J. BARTUSKA
PRIMARY EXAMINER